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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,499	12/08/2003	John J. Discko JR.	P-2167/CIP2/D1	2331

7590 01/11/2005  
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EXAMINER

FIDEI, DAVID

ART UNIT PAPER NUMBER

3728

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/730,499

**Applicant(s)**

DISCKO, JOHN J.

**Examiner**

David T. Fidei

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/19/04</u> .   | 6) <input type="checkbox"/> Other: ____                                     |

***Election/Restrictions***

1. Claims 1 and 6-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No 10/26/2004.
2. Applicant's election with traverse of invention in Paper No. 10/26/2004 is acknowledged. The traversal is on the ground(s) that the examiner has not established a serious burden. This is not found persuasive because the sheer number of species (**nineteen**) set forth in this application is sufficient for any reasonable person familiar the patent process to recognize a serious burden is presented. The examiner disagrees the nineteen species could competently be searched without any undue burden and it is unclear how applicant arrived at this conclusion. The details of some of the specific species require searching areas not required of the others. For example; the elected species 31, 32A & 32B requires the searching of containers with tear strips that would not be required of figures 1 or figure 18. The species of figure 18-20 would require searching of hinged containers not required of the previous two aforementioned species. .

Insofar as the criteria for restriction practice establishes, there is a prima facie showing provided by the initial holding. Applicant has not provided any showings demonstrating the contrary but merely alleges there is no serious burden.

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

The information disclosure statement filed March 19, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Those references have been lined-through and have not been considered.

The relevance of patent no. 5,184,710 (escalator apparatus) to the presently claimed subject is not clear.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (Patent no. 3,976,195) in view of Nason (Patent no. 4,803,048). In figures 1-3 a dispenser is disclosed as recited in claim 2 comprising a material to be applied (see col. 5, lines 38-40), an applicator (13) having an applying end portion (13a) and a handle (13b), a tray (12) having a material well (16a) adapted to receive and containing the material to be applied and an applicator well (16a) adapted to receive and hold the applying end portion of the applicator and a cover (26) attached to the tray covering the material well and the material and the applicator well and the applying end portion of the applicator. The difference between the claimed subject matter and Cohen resides in frangible portions are formed in the cover defining a strip extending over the material well without removing the cover.

Nason teaches a cover 12 that is quickly and easily removed from the remainder of the cover to expose the contents (col. 3, lines 43-45). The cover includes frangible portions spaced inward from the tray (col. 3, lines 50-51). Hence the differences between the claimed subject matter and Cohen are fairly taught by the prior art. It would have been obvious to one of ordinary skill in the art to modify Cohen by constructing the cover having frangible portions are formed in the cover defining a strip extending over the material well as taught by Nason, in order to quickly and easily remove the cover.

As to claim 3 the strip extends the length of the tray to permit access to the contents thereof.

As to claim 4, see col. 3, lines 43-45 of Nason. The use of the edges to wipe the application is of no patentable significance in the claim construction used. In order to further limit the claim there must be some distinction based upon the intended use recited. "However, in

apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE.

As to claim 5, a tab 28 is disclosed by that extends over the tray as shown by the gap of figure 2.

5. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aiken (Patent no. 4,786,534) in view of Nason (Patent no. 4,803,048). In figures 1-6 a dispenser is disclosed as recited in claim 2 comprising a material to be applied (24), a applicator (not numbered) having an applying end portion and a handle, a tray (22) having a material well (24) adapted to receive and containing the material to be applied and an applicator well (25) adapted to receive and hold the applying end portion of the applicator and a cover (21) attached to the tray covering the material well and the material and the applicator well and the applying end portion of the applicator. The difference between the claimed subject matter and Cohen resides in frangible portions are formed in the cover defining a strip extending over the material well without removing the cover.

Nason teaches a cover 12 that is quickly and easily removed from the remainder of the cover to expose the contents (col. 3, lines 43-45). The cover includes frangible portions spaced inward from the tray (col. 3, lines 50-51). It would have been obvious to one of ordinary skill in the art to modify Aiken by constructing the cover having frangible portions are formed in the cover defining a strip extending over the material well as taught by Nason, in order to quickly and easily remove the cover.

As to claim 3 the strip extends the length of the tray to permit access to the contents thereof.

As to claim 4, see col. 3, lines 43-45 of Nason. The use of the edges to wipe the application is of no patentable significance in the claim construction used for reasons cited in the previous rejection.

As to claim 5, a tab 28 is disclosed by that extends over the tray as shown by the gap of figure 2.

6. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynie (Patent no. 5,240,415) in view of Nason (Patent no. 4,803,048). In figures 1-6 a dispenser is disclosed as recited in claim 2 comprising a material to be applied (20), a applicator (24) having an applying end portion and a handle, a tray (12) having a material well (16) adapted to receive and containing the material to be applied and an applicator well (175) adapted to receive and hold the applying end portion of the applicator and a cover (14) attached to the tray covering the material well and the material and the applicator well and the applying end portion of the applicator. The difference between the claimed subject matter and Cohen resides in frangible portions are formed in the cover defining a strip extending over the material well without removing the cover.

Nason teaches a cover 12 that is quickly and easily removed from the remainder of the cover to expose the contents (col. 3, lines 43-45). The cover includes frangible portions spaced inward from the tray (col. 3, lines 50-51). It would have been obvious to one of ordinary skill in the art to modify Haynie by constructing the cover having frangible portions are formed in the cover defining a strip extending over the material well as taught by Nason, in order to quickly and easily remove the cover.

As to claim 3 the strip extends the length of the tray to permit access to the contents thereof.

As to claim 4, see col. 3, lines 43-45 of Nason. The use of the edges to wipe the application is of no patentable significance in the claim construction used for reasons given in the first rejection.

As to claim 5, a tab 28 is disclosed by that extends over the tray as shown by the gap of figure 2.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,660,273 in view of Nason (Patent no. 4,803,048). The difference between the previously patented subject matter and that presently claimed resides in frangible portions are formed in the cover defining a strip extending over the material well without removing the cover.

Nason teaches a cover 12 that is quickly and easily removed from the remainder of the cover to expose the contents (col. 3, lines 43-45). The cover includes frangible portions spaced inward from the tray (col. 3, lines 50-51). Hence the differences between the previously patented subject matter and that presently claimed are fairly taught by the prior art. It would have been obvious to one of ordinary skill in the art to modify prior patented subject matter by constructing the cover having frangible portions are formed in the cover defining a strip extending over the material well as taught by Nason, in order to quickly and easily remove the cover.

As to claim 3 the strip extends the length of the tray to permit access to the contents thereof.

As to claim 4, see col. 3, lines 43-45 of Nason. The use of the edges to wipe the application is of no patentable significance in the claim construction used for reasons given in the first rejection.

As to claim 5, a tab 28 is disclosed by that extends over the tray as shown by the gap of figure 2.

8. Claims 2-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,116,414 in view of Nason (Patent no. 4,803,048). The difference between the previously patented subject matter and that presently claimed resides in frangible portions are formed in the cover defining a strip extending over the material well without removing the cover.

Nason teaches a cover 12 that is quickly and easily removed from the remainder of the cover to expose the contents (col. 3, lines 43-45). The cover includes frangible portions spaced inward from the tray (col. 3, lines 50-51). Hence the differences between the previously patented subject matter and that presently claimed are fairly taught by the prior art. It would have been obvious to one of ordinary skill in the art to modify prior patented subject matter by constructing the cover having frangible portions are formed in the cover defining a strip extending over the material well as taught by Nason, in order to quickly and easily remove the cover.

As to claim 3 the strip extends the length of the tray to permit access to the contents thereof.

As to claim 4, see col. 3, lines 43-45 of Nason. The use of the edges to wipe the application is of no patentable significance in the claim construction used for reasons given in the first rejection.

As to claim 5, a tab 28 is disclosed by that extends over the tray as shown by the gap of figure 2.

9. Claims 2-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,328,159 in view of Nason (Patent no. 4,803,048). The difference between the previously patented subject matter and that presently claimed resides in frangible portions are formed in the cover defining a strip extending over the material well without removing the cover.



Nason teaches a cover 12 that is quickly and easily removed from the remainder of the cover to expose the contents (col. 3, lines 43-45). The cover includes frangible portions spaced inward from the tray (col. 3, lines 50-51). Hence the differences between the previously patented subject matter and that presently claimed are fairly taught by the prior art. It would have been obvious to one of ordinary skill in the art to modify prior patented subject matter by constructing the cover having frangible portions are formed in the cover defining a strip extending over the material well as taught by Nason, in order to quickly and easily remove the cover.

As to claim 3 the strip extends the length of the tray to permit access to the contents thereof.

As to claim 4, see col. 3, lines 43-45 of Nason. The use of the edges to wipe the application is of no patentable significance in the claim construction used for reasons given in the first rejection.

As to claim 5, a tab 28 is disclosed by that extends over the tray as shown by the gap of figure 2.

**REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION**

10. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).


### **Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
January 7, 2005